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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,195	01/21/2004	Kia Silverbrook	RRA30US	2170
24011	7590	04/28/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			GARCIA JR, RENE	
			ART UNIT	PAPER NUMBER
			2853	

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,195

Applicant(s)

SILVERBROOK, KIA

Examiner

Rene Garcia, Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 06 February 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/760,186 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al. (US 6,120,138) in view of Yuen (US 2004/0055661) and Rossell (US 6,386,871).

Xiao et al. disclose the following claimed limitations:

*regarding claim 11, printing fluid/**ink, 10/** dispenser/**ink supply, 300/** including:

*housing/**300/** comprising first/**case, 310/** and second/**plunger, 330/** portions movable relative to each other (base/**310/** includes cap/**334/** which plunger/**330/** moves through) (fig. 5)

*container (space between piston/**320/** and inner portion of case/**310/**) having an outlet/**nozzle, 314/** arranged to convey the printing fluid/**10/** to a point external/**cartridge, 400/** to the housing/**300/** (fig. 5; col. 3, lines 26-31) such that bringing the first/**310/** and second/**330/** portions towards each other causes egress of the printing fluid/**10/** through the outlet/**314/** (col. 3, lines 26-31)

*further regarding claim 7, first/**case, 310/** and second/**plunger, 330/** portions of the housing/**ink supply, 300/** comprise a base/**case, 310/** and plunger/**plunger, 330/** (fig. 5)

Xiao et al. does not disclose the following claimed limitations:

- *regarding claim 11, deformable container of printing fluid within the housing
- *resilient member disposed between the deformable container and the housing
- *resilient member has characteristics selected to limit pressure in the deformable container to a predetermined level in use

- *regarding claim 6, resilient member comprises a spring

- *regarding claim 8, spring is located between the deformable container and the plunger

Yuen disclose the following:

- *regarding claim 11, deformable container/**ink pouch, 16/** (paragraph 0047 & 0048) of printing fluid within the housing/**ink fill apparatus, 10/**

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a deformable container of printing fluid within the housing as taught by Yuen into Xiao et al. for the purposes of permitting ink pouch to be essentially flattened to force ink into cartridge.

Rossell disclose the following:

- *further regarding claim 11, resilient member/**spring, 11/** disposed between the deformable container/**space, 9/** and the housing/**sealing device, fig. 1 & 2/** for the purpose of applying a given force to be supported by membrane

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*resilient member has characteristics selected to limit pressure in the deformable container to a predetermined level in use (col. 4, lines 57-62) for the purpose of applying a given force to be supported by membrane

*regarding claim 6, resilient member/spring, 11/ comprises a spring/spring, 11/ (fig. 2) for the purpose of applying a given force to be supported by membrane

*regarding claim 8, spring is located between the deformable container and the plunger (fig. 2; spring is between plunger/actuating piston, 10/ and space/9/) for the purpose of applying force on the space/deformable bag/

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a resilient member disposed between the deformable container and the housing; resilient member has characteristics selected to limit pressure in the deformable container to a predetermined level in use; resilient member comprises a spring; and spring is located between the deformable container and the plunger as taught by Rossell into Xiao et al. for the purposes of applying a given force to be supported by membrane; and applying force on the space.

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4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al. (US 6,120,138) as modified by Yuen (US 2004/0055661) and Rossell (US 6,386,871) as applied to claim 11 and 6-7 above, and further in view of Prausnitz et al. (US 2003/0208167).

Xiao et al. as modified by Yuen and Rossell discloses all the claimed limitations except for the following:

*regarding claim 9, deformable container comprises a membrane

Prausnitz et al. disclose the following:

*regarding claim 9, deformable container comprises a membrane/sponge/ (paragraphs 0033 & 0034)

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize deformable container comprises a membrane deformable as taught by Prausnitz et al. into Xiao et al. as modified by Yuen and Rossell for the purpose of retaining the drug liquid until the material/membrane/ is compressed.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al. (US 6,120,138) in view of Yuen (US 2004/0055661) and Rossell (US 6,386,871).

Xiao et al. disclose the following claimed limitations:

*regarding claim 10, printing fluid/ink, 10/ dispenser/ink supply, 300/ including: (fig. 5)

*housing/300/ comprising a base/case, 310/ and a plunger/plunger, 330/ (fig. 5)

*outlet/nozzle, 314/ arranged to convey the printing fluid/10/ to a point external/cartridge, 400/ to the housing/300/ (fig. 5; col. 3, lines 26-13)

*in use, bringing the plunger/330/ towards the base/310/ causes the egress of the printing fluid/10/ through the outlet/314/ (fig. 5; col. 3, lines 26-31)

Xiao et al. does not disclose the following claimed limitations:

*regarding claim 10, deformable container located within the housing for storing printing fluid

*spring located between the deformable container and the plunger having characteristics selected to limit pressure in the deformable container to a predetermined level in use

*in use, bringing the plunger towards the base causes compression of the deformable container between the spring and the base

Yuen disclose the following:

*regarding claim 10, deformable container/**ink pouch, 16/** (paragraph 0047 & 0048) located within the housing/**ink fill apparatus, 10/** for storing printing fluid/**ink/** (figs. 4 & 5) for the purpose of permitting ink pouch to be essentially flattened to force ink into cartridge

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a reservoir comprises a deformable container located within the housing and wherein bringing the first and second portions towards each other causes compression of said container as taught by Yuen into Xiao et al. for the purposes of permitting ink pouch to be essentially flattened to force ink into cartridge.

Rossell disclose the following:

*further regarding claim 10, spring/**11/** located between the deformable container/**space, 9/** and the plunger/**actuating piston, 10/** having characteristics selected to limit pressure in the deformable container/**space, 9/** to a predetermined level in use (col. 4, lines 57-62) for the purpose of applying a given force to be supported by membrane

*in use, bringing the plunger/actuating piston, 10/ towards the base/syringe, 5/ causes compression of the deformable container/space, 9/ between the spring/11/ and the base/syringe, 5/ (shown in fig. 2) purpose of applying a given force to be supported by membrane

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a spring located between the deformable container and the plunger having characteristics selected to limit pressure in the deformable container to a predetermined level in use; and bringing the plunger towards the base causes compression of the deformable container between the spring and the base as taught by Rossell into Xiao et al. for the purpose of applying a given force to be supported by membrane.

Response to Arguments

6. Applicant's arguments filed 06 February 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments that Xiao and Yuen provide no motivation to devise a safeguard against overloading the deformable container, the fact that applicant uses a first and second portion movable relative to each other for a different purpose does not alter the conclusion that its use in a prior art device would be *prima facie* obvious from the purpose disclosed in the reference. **In re Lintner, 173 USPQ 560.**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., safeguard against overloading the deformable container) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Xiao, Yuen and Rossell is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rossell discloses a vacuum pump [syringe structure – two portions that move relative to each other] for providing a fluid substance to a cavity; Xiao and Yuen both disclose the use of a structure with two portion that move relative each other for providing liquid [ink] to a cartridge container. Therefore Xiao, Yuen and Rossell are analogous art in that they provide a structure (movable portions) for providing fluid to an embodiment (cavity, hole container etc.).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

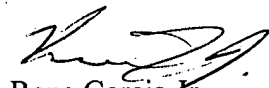
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Communications with the USPTO

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rene Garcia Jr
24 April 2006

11-411-4/06
K. FEGGINS
PRIMARY EXAMINER